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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/906,952 . 08/06/97 LU

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EXAMINER

MMC2/1229

TRIAL & TECHNOLOGY LAW GROUP
PROFESSIONAL LAW CORPORATION
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MAI, A

ART UNIT

PAPER NUMBER

2832

#14

DATE MAILED:

12/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

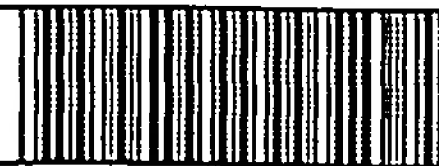
Office Action Summary

Application No.
08/906,952

Applicant(s)
Lu et al

Examiner
Anh Mai

Group Art Unit
2832



☒ Responsive to communication(s) filed on Oct 10, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-40 is/are pending in the application.

Of the above, claim(s) 36-40 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2-35 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Since there is no indication of a change in election is desired in this application, the prosecution is being continued on the invention elected and prosecuted by applicant in the parent application. In the instant application, claims 2-35 have been examined and claims 36-40 have been withdrawn from further consideration.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the preamble of claim 2, a package is the device claimed. In line 4 of the claim, the transformers cannot be carried within the package; they are part of the package.

With respect to claims 6, 11, 20, 30, the package *is not* one piece, the package many pieces.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Renskers.

Renskers discloses an electronic surface mount package comprising:

- a side wall with bottom end [figure 1];
- plurality of toroid transformers 52 in the package each having wires wrapped around [figure 2];
- a plurality of terminal pins 32.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-18 and 21-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renskers in view of Matsumura et al.

Renskers discloses an electronic surface mount package comprising:

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- a side wall with bottom end [figure 1];
- plurality of toroid transformers 52 in the package each having wires wrapped around [figure 2];
- a plurality of terminal pins 32, molded within the side wall 12 and having solder posts.

Renskers discloses the claimed invention except for terminal pins molded on the side walls. Matsumura discloses terminal pins molded in side walls 35b to provide a firm anchor for the terminal. It would have been obvious to a person of ordinary skill in the art to mold the pins on side walls as taught by Matsasura to Renskers.

Response to Arguments

5. Applicant's arguments filed April 9, 1999 have been fully considered but they are not persuasive.

Applicant argues that Renskers is for DIP while applicant's invention is for SMP. It is noted that the preamble "*for* mounting onto the surface of a printed circuit board" does not mean the package *is mounted* on the board. The pin 38 can be mounted on top of a PCB or can extend through holes of PCB. The claim neither include or exclude such arrangement. Also, intended use has no patentable significance.

With respect to claim 19, *it does not define a plurality of terminal pins molded within the side wall* as indicated by applicant. Claim 19 merely has "*a plurality of terminal pins molded within the package*" as clearly seen in figure 6 of Renskers. The encapsulant above resilient foam 60 has the pins 32 molded within the package.

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Applicant's claim language does not exclude the leg connection 42 from being encapsulated or molded. Claim 19 also does not have the solder joints below the bottom of the side wall. Even so, the post ends extend beyond the bottom end of the side wall; the bottom end of side walls 28 extends to a height less than the depression 22 and the posts extend beyond the bottom end of the side wall. This is true even if joints 42 are folded back into the cavity and encapsulated. The encapsulation is not excluded by applicant's claim language. Also, the ends 42 are below and beyond the bottom of the side walls.

Conclusion

6. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Mai whose telephone number is (703)308-2900.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Gellner, can be reached at (703) 308-1721. The facsimile numbers for Technology Center 2800 are (703) 305-3422 or 305-1341.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist of the Technology Center whose telephone number is (703) 308-1782.



Anh Mai

Patent Examiner, AU 2832

December 27, 2000